

PATENT
Customer No. 22,852
Attorney Docket No. 09797.0002-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Peiyuan WANG et al.) Group Art Unit: 1612
Application No.: 10/632,997) Examiner: Benjamin J. Packard
Filed: August 1, 2003)
For: COMPOUNDS WITH THE) Confirmation No.: 8974
BICYCLO[4.2.1]NONANE)
SYSTEM FOR THE TREATMENT)
OF FLAVIVIRIDAE INFECTIONS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA EFS-Web

Sir:

RESPONSE TO SPECIES ELECTION REQUIREMENT

In the Species Election Requirement mailed February 23, 2009 (the "Species Election"), the Examiner vacates the previous Requirement Restriction dated December 17, 2008, and required election of a new species under 35 U.S.C. § 121 for currently pending claims 13-37, selected from the compounds of general formula (I) in claim 13. Species Election at 2. The Examiner notes that the compound 1(J) recited in claim 21 "will also be included in the search as the previous Examiner suggested it was free of the prior art." *Id.* Applicant provisionally elects with traverse claims drawn to a compound of formula 1(O) in addition to the earlier-elected compound of formula 1(J). Elected species 1(O) is believed to read on currently pending claims 13-18, 21-25, 27, and 32, and previously elected species 1(J) is believed to read on currently pending

claims 13-18, 20-25, 27, and 30. Claims 1-12 remain withdrawn as relating to a non-elected invention.

Applicant traverses the Examiner's requirement of a second species election since the M.P.E.P. only permits the Office to require election of "a single disclosed species" when a requirement for restriction is made under 35 U.S.C. § 121. M.P.E.P. § 808.01(a) states that "[w]hen a requirement for restriction between either independent or distinct species is made, applicant must elect **a single disclosed species . . .**" See also M.P.E.P. § 803.02 ("In applications containing a Markush-type claim . . . , the examiner may require a provisional election of **a single species** prior to examination of the merits."); M.P.E.P. § 809.02(a) (stating the actions to be taken when election of species is required: "Applicant should then be required to elect **a single disclosed species** under 35 U.S.C. § 121. . . .") (emphases added). Because Applicant previously elected a species, the compound of formula 1(J), in response to the Restriction Requirement issued by the previous Examiner on November 30, 2006, it is improper for the Office to now require the election of a second species.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Office, Applicant respectfully requests that the second Species Election Requirement be reconsidered and withdrawn.

Interview Summary

Applicant would like to thank Examiners Packard and Fetterolf for the courtesy of the telephonic interview conducted on January 13, 2009, with William Strauss and Krista Bianco. During the interview, the parties generally discussed the December 17, 2008, Restriction Requirement, which was mailed after a change in Examiners, and

Examiner Packard agreed to issue a new clarified restriction, which was subsequently mailed February 23, 2009.

By virtue of the facts that the period for response has been extended to August 24, 2009 (August 23, 2009, falling on a Sunday) by a request for a five-month extension of time and fee payment filed concurrently herewith, this response is timely filed.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, the Examiner is respectfully urged to contact Applicant's undersigned counsel at 202-408-4069.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 21, 2009

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